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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,576	11/25/2003	Shinichiro Kawasaki	81940.0064	5791
26021	7590	03/09/2006	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			LAM, DUNG LE	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/721,576	KAWASAKI ET AL.	
	Examiner	Art Unit	
	Dung Lam	2687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,13,14,21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-12,15-20 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Specification***

1. The objection to the title is withdrawn.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **1, 11 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haller** (US Pub. No. 2004/0068570) in view of **Jiang** (US Patent No. 6898432).

4. **Haller** teaches a portable terminal that performs a plurality of functions to reproduce and execute digital contents, the portable terminal comprising:

a module that displays the list of contents (Fig. 7, Col. 6, para. 75)

a module (menu software component 414, Col. 6 para. 74) that provides a list of contents including estimated communication costs (download prices and menu 703, Col. 6, para. 74) to obtain the respective contents or estimated communication times to obtain the respective contents.

a module that calculates the estimated communication costs and the estimated communication times of the contents in the list based on the locations of the contents and a current position of the portable terminal (Haller's para. 79, 80);

a plurality of communication devices (312 and 310, Fig. 3a) that communicate with a contents server via a plurality of networks including a wide area wireless network (WAN 105 and Short Distance Wireless Network, 116), a local area wireless network or a local wire network (Please note “or” indicates optional limitation and is not required. However, for applicant’s convenience, the examiner notes that this limitation is also addressed in applicant’s background of invention paragraph 5 which can be treated as admitted prior art).

**However**, Haller fails to disclose that the module also provides the locations of the contents and a module that estimates a new communication path to a new location of the content which becomes available when moving the portable terminal by a specified distance, a communication time to obtain the content through the new communication path, or a communication cost to obtain the content through the new communication path. In an analogous art, **Jiang** teaches that as the user moves through different network, he/she can view the options of paying more with shorter time or paying less with longer time (e.g. different time and associated cost options such as obtaining content less than five seconds at a cost of \$.50 or obtaining content less than five minutes at a cost of \$.01, col. 8 ln 60 – col. 9 ln 11). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Haller’s content downloading portable terminal with **Jiang**’s teaching of providing the different costs associated time to give the users the flexibility and more information to compare with before deciding which source of content providers best fit their time and financial budget.

Art Unit: 2687

5. Regarding **claims 11 and 20**, they describe an apparatus and method that correspond to claim 1. Therefore, they are rejected for the same reasons as claim 1.

6. Claims **1, 4-12, 15-20 and 23-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haller** (US Pub. No. 2004/0068570) in view of **Rautila** (US Patent No. 6714797).

7. **Haller** teaches a portable terminal that performs a plurality of functions to reproduce and execute digital contents, the portable terminal comprising:

a module that displays the list of contents (Fig. 7, Col. 6, para. 75)

a module (menu software component 414, Col. 6 para. 74) that provides a list of contents including estimated communication costs (download prices and menu 703, Col. 6, para. 74) to obtain the respective contents or estimated communication times to obtain the respective contents.

a module that calculates the estimated communication costs and the estimated communication times of the contents in the list based on the locations of the contents and a current position of the portable terminal (Haller's para. 79, 80);

a plurality of communication devices (312 and 310, Fig. 3a) that communicate with a contents server via a plurality of networks including a wide area wireless network (WAN 105 and Short Distance Wireless Network, 116), a local area wireless network or a local wire network (Please note "or" indicates optional limitation and is not required. However, for applicant's convenience, the examiner notes that this limitation is also addressed in applicant's background of invention paragraph 5 which can be treated as admitted prior art).

**However**, Haller fails to disclose that the module also provides the locations of the contents and a module that estimates a new communication path to a new location of the content which becomes available when moving the portable terminal by a specified distance, a communication time to obtain the content through the new communication path, and a communication cost to obtain the content through the new communication path. In an analogous art, **Rautila** teaches that the users can select which location they want to download the content from and that one provider location is a more economical choice than another (Col. 4, lines 41-64). Further, Haller teaches that the download rate is dependent on the user location and time (par. 79). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Haller's content downloading portable terminal with Rautila's teaching of providing the location to allow users to make better decision in selecting the contents that best fit their time and financial budget based on the location. Rautila further teaches a mobile device that can receive information regarding the nearest hotspot network locations based on user's current location (Col. 8, lines 27-32 and Fig. 7) and also allows user to select which location to download the digital content from based on estimated time and a cost benefit analysis (Col. 4, lines 53-63 and lines 16-18). Therefore, it would have been obvious for one of ordinary skill in the art at the time of invention to further modify Haller with Rautila's teaching to better inform the mobile user of a new location and its associated new cost to allow users to make a most economical and satisfaction guaranteed choice in downloading contents.

8. Regarding **claim 4, Haller and Rautila** teach all the limitations of claim 1.

Rautila further teaches a module that judges if the new communication path provides at least one of a shorter communication time (Col. 4, lines 59-63 and Fig. 7) and a lower communication cost than communication paths from the current location of the portable terminal to the locations of the contents.

9. Regarding **claim 5, Haller and Rautila** teach all the limitations in claim 4.

Rautila further teaches a module that proposes to move the portable terminal to the new location when a positive judgment is made (Col. 4, lines 59-63 and Fig. 7).

10. Regarding **claim 6, Haller and Rautila** teach all the limitations in claim 5.

Rautila further teaches a new communication path is proposed when the new communication path provides both a shorter communication time (Col. 4, lines 59-63 and Fig. 7). Rautilla further teaches an inherent lower communication cost path, his teaching of a cost benefit analysis for downloading the content (Col. 4, lines 59-63) implies that his teaching is capable of proposing a cost effective method of downloading. Therefore it would have been obvious for one of ordinary skill in the art at the time of the invention to further include a lower cost path proposal to allow users to save some money by selecting the lower cost choice.

11. Claims **7 and 8** are rejected for the same reasons as claim 6.

12. Regarding **claim 9, Haller and Rautila** teach all the limitations in claim 3.

Rautila further teaches a display device (200, Fig. 2) that inherently displays the locations of the contents as selectable items, and an inherent selection module that selects one of the locations of the contents displayed on the display device (Col. 6, lines

Art Unit: 2687

15-18 and Col. 4, lines 57-59). Since Rautilla discloses that the user can opt to download from either the electronic shop server or the hotspot network, it is inherent that the options has to be somehow displayed and the selected option has be processed by an inherent selection module.

13. Claim **10** is rejected for the same reasons as claim 9.

14. Regarding **claim 11, Haller and Rautila** teach all the limitations in claim 1. Haller further teaches in paragraph 56 that the digital contents include at least music data (ring tone), picture data (an image file, gif, jpeg) and program data (.EXE file).

15. Regarding claims **12-19**, they are similar to claims 1-8 with a few additional limitations. Therefore claims 12-19 are rejected for the same reasons as claims 1-8 with the following additional limitations. Haller also teach a content server (101 Fig.1 and para. 51) that is capable of recording digital contents including music data (ring tone para. 56), picture data (image para. 56), program data (.EXE File para. 56); and a module (602 software transfer para. 51 and Fig. 8) that distributes the digital contents to a portable terminal.

16. Regarding **claims 23-29**, they are the method claims corresponding to the apparatus claims of 4-10 respectively. Therefore, they are rejected for the same reasons as claims 4-10.



### ***Response to Arguments***

Applicant's arguments with respect to claims 1,4-12,15-20 and 23-29 filed on 12/22/05 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Lam whose telephone number is (571) 272-6497. The examiner can normally be reached on M - F 9 - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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